

Supreme Court, U. S.

**FILED**

MAY 11 1977

MICHAEL RODAK, JR., CLERK

IN THE

**Supreme Court of the United States**

OCTOBER TERM, 1976

No. \_\_\_\_\_

**76-1575**

CONTROL DATA CORPORATION, *Petitioner*

v.

TECHNITROL, INC., *Respondent*

**PETITION FOR WRIT OF CERTIORARI TO THE  
COURT OF APPEALS FOR THE FOURTH CIRCUIT**

ALLEN KIRKPATRICK, III  
1801 K Street, N.W.  
Eighth Floor  
Washington, D.C. 20006  
Telephone: 202/833-3000  
*Attorney for Petitioner*

*Of Counsel:*

LARRY S. NIXON  
CUSHMAN, DARBY & CUSHMAN  
1801 K Street, N.W.  
Washington, D.C. 20006

JOSEPH A. GENOVESE  
CONTROL DATA CORPORATION  
6003 Executive Boulevard  
Rockville, Maryland 20852

## TABLE OF CONTENTS

	Page
1. The Opinions Below .....	1
2. Statement of Jurisdictional Grounds .....	2
3. The Questions Presented .....	2
4. The Statute Involved .....	3
5. Reasons for Review by This Court .....	4
6. Statement of the Case .....	5
a. Procedural Facts .....	5
b. Technical Facts .....	7
7. Argument .....	10
a. Patent Claims Must Be Definite .....	10
b. The Error of the Court Below .....	13
c. Application of 35 U.S. Code 112 .....	16
d. Claims Must Recite the Vital Feature of the Al- leged Invention .....	18
e. Summary Judgment Below Should Not Preclude Review by This Court .....	21
Conclusion .....	22

## APPENDIX

(Separately Bound)

Opinion of the Court below, <i>Technitrol, Inc. v. Control Data Corporation</i> , No. 75-1857 (4th Cir., Decided Mar. 8, 1977) .....	1
Opinion of the District Court, <i>Technitrol, Inc. v. Con- trol Data Corporation</i> , 394 F. Supp. 511 (D. Md. 1975) .....	30
Denial of Petition for Rehearing in the court below ..	39

	Page
Opinions in related case in Court of Claims	
<i>Technitrol, Inc. v. United States</i> , 164 U.S.P.Q. 51 (Ct. Cl. Comm'r 1969) .....	40
<i>Technitrol, Inc. v. The United States</i> , 440 F.2d 1363 (Ct. Cl. 1971) .....	47
U.S. Patent No. 2,611,813, "Magnetic Data Storage System", granted September 23, 1952 .....	60
Page A132 of the Joint Appendix below .....	78

## TABLE OF CASES

<i>General Electric Co. v. Wabash Appliance Corp.</i> , 304 U.S. 364 (1938) .....	12
<i>Graham v. John Deere Co.</i> , 383 U.S. 1 (1966) .....	11
<i>Halliburton Oil Well Cementing Co. v. Walker</i> , 329 U.S. 1 (1946) .....	16
<i>In re Birnbaum</i> , 161 U.S.P.Q. 635 (1968) .....	20
<i>In re Lundberg</i> , 244 F.2d 543 (C.C.P.A. 1957) .....	17
<i>In re Williams</i> , 180 U.S.P.Q. 460 (1972) .....	20
<i>Henry J. Kaiser Co. v. McLouth Steel Corp.</i> , 257 F. Supp. 372 (E.D. Mich. 1966) .....	18, 19, 20
<i>Kaiser Industries Corp. v. McLouth Steel Corp.</i> , 400 F.2d 36 (6th Cir. 1968), cert. denied, 393 U.S. 1119 (1969) .....	18
<i>Sears, Roebuck &amp; Co. v. Stiffel Co.</i> , 376 U.S. 225 (1964) .....	11, 13
<i>Technitrol, Inc. v. Control Data</i> , 394 F. Supp. 511 (D. Md. 1975) .....	6, 14
<i>Technitrol, Inc. v. United States</i> , 164 U.S.P.Q. 51 (Ct. Cl. Comm'r 1969) .....	6
<i>Technitrol, Inc. v. United States</i> , 440 F.2d 1363 (Ct. Cl. 1971) .....	5, 9, 14, 15
<i>White v. Dunbar</i> , 119 U.S. 47 (1886) .....	11

## OTHER AUTHORITIES

U.S. Constitution, Art. 1, Sec. 8 .....	4
Title 28 United States Code	
Section 1254 .....	2
Section 1338(a) .....	5
Title 35 United States Code	
Section 112 .....	2, 3, 4, 7, 14, 15, 16, 17, 18, 21
Section 251 .....	11
Section 252 .....	11

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1976

No.

TECHNITROL, INC., *Respondent*

v.

CONTROL DATA CORPORATION, *Petitioner*

**PETITION FOR WRIT OF CERTIORARI TO THE  
COURT OF APPEALS FOR THE FOURTH CIRCUIT**

**1. THE OPINIONS BELOW**

The opinion of the court below, the Court of Appeals for the Fourth Circuit, now sought to be reversed was filed March 8, 1977, but is not yet reported. A copy is appended hereto. The opinion of the District Court for the District of Maryland sought to be reinstated was filed May 13, 1975, and is reported at 394 F. Supp. 511. A copy is appended hereto.



## 2. STATEMENT OF JURISDICTIONAL GROUNDS

This is a civil case for patent infringement. The jurisdiction of this Court is invoked under 28 U.S. Code 1254, which provides that,

"Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree; . . ."

The opinion below was filed March 8, 1977. A petition for rehearing was filed March 21, 1977, but an order of denial was filed April 11, 1977. A copy of the latter is appended hereto. The mandate has been stayed pending the outcome of this petition.

## 3. THE QUESTIONS PRESENTED

(1) Whether patent claims should be interpreted as including anything the patentee may later assert at trial as his intention to have claimed or whether patent claims should be interpreted as including only that which is actually recited and that which is necessarily or causally linked to actual claim recitations?

(2) Whether it should be impossible for a patentee to alter the scope of a "means plus function" type patent claim<sup>1</sup> by bringing an additional feature from the specification into the claim although not expressly recited in the claim in an attempt to overcome a defense presented during an infringement action after it is too

<sup>1</sup> We use "means plus function" here and hereafter as a convenient abbreviation of the "... means or step for performing a specified function . . ." provision of 35 U.S. Code 112, paragraph 3.

late for the accused party to change its equipment to avoid alleged infringement?

(3) Whether a patent claim of the "means plus function" type is invalid under 35 U.S. Code 112 for failure to particularly point out and distinctly claim an invention where the invention asserted during an infringement action is a feature described in the specification of the patent but which feature is not recited in the claim as granted and the feature is not necessary to successfully achieve the specific function actually recited in the claim?

(4) Whether any claim of a group of "means plus function" type patent claims directed to a given system can be valid as definite under 35 U.S. Code 112 where the patentee admits that no claim expressly recites an alleged vital feature of the intended invention, and where the patentee admits that one claim does not include the alleged feature in the functional recitation of the claim, while the patentee contends that the other claims having recitations of the same function do include such feature?

## 4. THE STATUTE INVOLVED

This case involves the proper construction of 35 U.S. Code 112, which provides:

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

"The specification shall conclude with one or more claims particularly pointing out and dis-

tinctly claiming the subject matter which the applicant regards as his invention. A claim may be written in independent or dependent form, and if in dependent form, it shall be construed to include all the limitations of the claim incorporated by reference into the dependent claim.

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (Amended July 24, 1965, Public Law 89-93, sec. 9, 79 Stat. 261.)"

It is the first sentence of the second paragraph and the third paragraph which are directly involved in this case.

#### 5. REASONS FOR REVIEW BY THIS COURT

Review by this Court is necessary to clarify and settle an area of patent law so that the rights of the public may prevail under the Constitution, Article 1, section 8, and past decisions of this Court. The error below arises by misconstrual of the third paragraph of the statute involved, 35 U.S. Code 112, which has not been construed by this Court since its enactment in 1953. The court below, in reversing the district court, has decided the foregoing federal questions (involving the statutory requirement to particularly point out and distinctly claim that which is regarded as the invention) in conflict with applicable decisions of this Court and in conflict with a decision of another court of appeals, thereby leaving important questions of federal patent law unsettled. By its decision the court below makes new law in permitting a patentee to alter the scope of its patent claims after the

grant of the patent in an attempt to overcome a defense in an infringement litigation and in a manner which makes the actual claim scope ascertainable only after a court determination of the inventor's previously unstated intentions rather than from the actual claim language. Such ability to freely manipulate the scope of patent claims should not be tolerated, as it is contrary to the patent statutes and to public policy. This important area of patent law should therefore be settled promptly by this Court before it spreads to other cases and to other circuits.

#### 6. STATEMENT OF THE CASE

##### a. Procedural Facts

This is a case for patent infringement, commenced on September 19, 1966 in the U.S. District Court for Maryland, jurisdiction therein being conferred by 28 U.S. Code 1338(a). The patent is Sharpless et al No. 2,611,813, "Magnetic Data Storage System", granted on September 23, 1952, owned by plaintiff-appellant below (hereafter, "patentee"). A copy is appended hereto. A description of the system is provided *infra*.

The crux of the case is that the court below, reversing the district court, has permitted the patentee to change the scope of the patent claims so as to include a feature which is not recited in the claims as they appear in the patent, the feature not being necessary to successfully achieve the function actually recited in the claims. The feature is described *infra* and referred to herein as the "reset feature".

During the pendency of the case in the district court the patentee also sued the United States in the Court of Claims for unlicensed use of the patent under 28 U.S. Code 1498. However, the Court of Claims held [*Technitrol, Inc. v. United States*, 440 F.2d 1363, 1364,



1375 (1971)]<sup>2</sup> that each claim of the patent was freely licensed to the United States (under certain contracts with the United States) unless each claim included the reset feature. Patentee then engaged in an assertion that the claims (except for one) included the reset feature. The reset feature was said by patentee to be "vital" to the alleged invention<sup>3</sup> to avoid "position volatility". The patentee then settled with the United States for a considerable sum of money.

Before the Court of Claims incident there had been no inkling by patentee that its claims were limited to the reset feature. The claims are silent in that regard. Patentee was placing a broad interpretation on its claims, *e.g.*, was understood to be accusing as infringements systems using tape transports, which are not position volatile and do not need or have the reset feature. The prospect of easily invalidating the claims was excellent, because of prior art descriptions of similar systems without the reset feature. Some prior art systems described ways to avoid position volatility without use of a reset feature, *e.g.*, a Schmidt system so found by the Court of Claims Commissioner in a Finding of Fact No. 29. If the claims are limited to the reset feature they would be considerably more time consuming and expensive to invalidate because more prior art must be relied upon. Perhaps even more importantly, although it is possible to avoid use of the reset feature and hence avoid allegations of infringe-

<sup>2</sup> For earlier proceedings in the Court of Claims, see also the decision of the trial commissioner at 164 U.S.P.Q. 51 (Ct. Cl. Comm'r 1969). Copies of both decisions are appended hereto.

<sup>3</sup> See decision of the district court, 394 F. Supp. at 515, right column, second paragraph. Also, page A132 of the Joint Appendix below, a copy being appended hereto.

ment of any claim including such feature, neither the defendant nor the remainder of the public has had any way to know that the patent claims in question would be so construed until recently.

When Petitioner learned of the new construction placed by patentee upon its claims, a motion promptly was filed in the district court for dismissal of the case under 35 U.S. Code 112, on the ground that the claims were invalid for not "—particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention." The district court, correctly perceiving the fault of the claims, rendered its opinion of May 13, 1975 holding all of the claims of the patent invalid, and dismissed the case.

The court below, taking one claim (claim 19) as representative, held it to include the reset feature. The court ignored the fact that claim 19 uses functional language as general as another claim (claim 16) which patentee admits does not include the reset feature.

#### b. Technical Facts

The patent in suit describes a system for the storage of information or data on revolving magnetizable discs. An electronic counter, driven by marks or "pulses" along one track on one disc, serves to generate successive voltage combinations at the counter output which are used to locate or select particular areas or "registers" in data tracks on other discs. This selection technique is recited in the emphasized<sup>4</sup> portions of claim 19 of the patent now set forth:

"In an information storage system,

1. "magnetic recording means having a plurality of information recording sections constitu-

<sup>4</sup> All emphasis in this petition is supplied.

ting registers and also having a register-selection section on which are recorded pulses coordinated with said registers.

2. "means for producing from said recorded pulses different *successively-occurring register-selection voltage combinations representative respectively of said registers*,

3. "means under control of an operator at a remote position *for producing a group of pulses indicative of a particular register* and also containing numerical information which it is desired to store in that register,

4. "means responsive to some of said pulses for producing a pattern of voltages,

5. "*means responsive coincidently to said voltage combinations<sup>5</sup> and said voltage pattern for selecting said register*,

6. "and means for storing said numerical information in said register."

The "reset feature" is additional equipment which serves to reset the counter into synchronism with the revolving discs in the event an earlier power failure has permitted them to fall out of step. However, the reset feature is not necessary to the basic location or selection function during normal usage. The court below agreed, see its statement at page 7 of its decision:

"There is general agreement here (not later binding)<sup>6</sup> that a previous magnetic storage system or systems accurately located the registers as long as operations continued without interruption."

<sup>5</sup> The court below omitted the word "combinations" from the claim in its footnote 2.

<sup>6</sup> What the court below meant by "not later binding" is unknown.

The Court of Claims reached the same conclusion:

"During *normal* operation, with power on and the equipment functioning properly, the clock disk and counter will stay synchronized [without the reset feature]." *Technitrol, Inc. v. United States*, *supra*, at pp. 1365-66.

The district court relied on claim 16 to emphasize the fact that claim 19 does not "—particularly point out and distinctly claim—" the reset feature. The patentee admits claim 16 does not include the reset feature.<sup>7</sup> Claim 16 reads:

"A system for magnetic storage of a plurality of data respectively relating to different items of information,

1. "comprising a magnetic member having a plurality of magnetizable data storage portions<sup>8</sup> respectively assignable to said different items of information,

2. "a magnetic recording and reading device adjacent to said magnetic storage member *for selectively magnetizing any of said data storage portions for storing data thereon or alternatively for taking a reading of data previously stored thereon*,

3. "*means for transmitting signals including item selection signals* to said storage apparatus,

4. "means for causing continuous relative rotation between said magnetic storage member and said magnetic recording and reading device

<sup>7</sup> See 440 F.2d at 1375, left column, "... claim 16 ... is agreed by the parties to be entirely independent of the automatic reset device."

<sup>8</sup> The "storage portions" here are the same as the "registers" of claim 19, because there is only one exemplary system described in the patent specification.



for continuously scanning said plurality of data storage portions,

5. "circuits separately operable through said magnetic recording and reading device for causing the device to record or read as desired,

6. "*selective means responsive to the received signals for rendering a desired one of said circuits operable,*

7. "*and means including a gating circuit having space discharge tubes and whose timing is controlled by the received selection signals and the instantaneous position of said recording and reading device relative to that of a data storage portion selected, thereby to effect a desired recording or reading operation.*"

The emphasized portions of claim 16 pertain to the same selection function of *the same equipment* as in claim 19, there being *only one* exemplary system described in the patent. However, no significant difference in language exists so as to find the reset feature included in claim 19 but not in claim 16. (As aforesaid, the court below ignored claim 16 in reaching its conclusion.)

## 7. ARGUMENT

### a. Patent Claims Must Be Definite

Patent claims must be definite, and fixed in scope. A patent system with flexible claims which are variable at the will of the patentee to suit its changing *intentions* is unworkable in the United States, with its firm policy and laws against illegal monopolies. Members of United States industries should not be required to spend vast sums of money in litigation to determine the scope of every patent claim that may affect them.

It should be impossible for patentees freely to alter the scope of their claims after grant of the patent<sup>9</sup> in attempts to avoid defenses asserted against them in infringement actions. If patentees were to be permitted to alter claim scope at will then all of the evils of unlimited monopolies would be fostered on the public. This Court has often spoken out against such practices. The "*—instinctive aversion to monopolies—*" shared by Jefferson and other Americans, and the need to curtail them, is developed at length by this Court in *Graham v. John Deere Co.*, 383 U.S. 1, 7-10 (1966). See also this Court in *Sears, Roebuck & Co., v. Stiffel Co.*, 376 U.S. 225, 231 (1964):

"But in rewarding useful invention, the 'rights and welfare of the community must be fairly dealt with and effectually guarded.' *Kendall v. Winsor*, 21 How 322, 329, 16 L.Ed. 165, 168 (1859). To that end the prerequisites to obtaining a patent are strictly observed, *and when the patent has issued the limitations on its exercise are equally strictly enforced. . . . Once the patent issues, it is strictly construed, . . .*"

This Court has ruled generally on the requirement for fixed claim scope, see *White v. Dunbar*, 119 U.S. 47, 52 (1886), which admonished against claims being noses of wax:

"Some persons seem to suppose that a claim in a patent is like a nose of wax which may be turned and twisted in any direction, by merely referring to the specification, so as to make it include something more than, or something different from, what its words express. The context may un-

<sup>9</sup> Except for reliance on the patent re-issue statutes having the protection of intervening rights, 35 U.S. Code 251, 252, which were not used in this case.



doubtedly be resorted to, and often is resorted to, for the purpose of better understanding the meaning of the claim; but not for the purpose of changing it and making it different from what it is. The claim is a statutory requirement, prescribed for the very purpose of making the patentee define precisely what his invention is; and it is unjust to the public, as well as an evasion of the law, to construe it in a manner different from the plain import of its terms. This has been so often expressed in the opinions of this court that it is unnecessary to pursue the subject further. See *Keystone Bridge Co. v. Phoenix Iron Co.*, 95 U.S. 274, 278 [Bk. 24, L.ed. 344, 345]; *James v. Campbell*, 104 U.S. 356, 370 [Bk. 26, L.ed. 786, 791]."

The requirement for definite claiming also was addressed by this Court in *General Electric Co. v. Wash Appliance Corp.*, 304 U.S. 364, 368-69 (1938):

"Recognizing that most inventions represent improvements on some existing article, process or machine, and that a description of the invention must in large part set out what is old in order to facilitate the understanding of what is new, Congress requires of the applicant 'a distinct and specific statement of what he claims to be new, and to be his invention.' Patents, whether basic or for improvements, must comply accurately and precisely with the statutory requirement as to claims of invention or discovery. The limits of a patent must be known for the protection of the patentee, the encouragement of the inventive genius of others and the assurance that the subject of the patent will be dedicated ultimately to the public. The statute seeks to guard against unreasonable advantages to the patentee and disadvantages to others arising from uncertainty as to their rights. The inventor must 'inform the public during the life of the patent of the

limits of the monopoly asserted, so that it may be known which features may be safely used or manufactured without a license and which may not.' The claims 'measure the invention.' " (footnotes omitted).

#### b. The Error of the Court Below

However, the court below would permit deviation from the aforesaid rule in the case of "means plus function" type claims. The error by the court is in permitting the patentee, in its effort to avoid a defense in an infringement action, to bring into the claims a feature in the specification (the "reset feature" alluded to above) which is not necessary to accomplish the function actually recited in the claims. Thus the court below does exactly the opposite of the strict construction required under *Sears, supra*.

The way the court below got into its error was to construe claim 19 on the basis that it included what the court felt the alleged inventors *intended* their system to include.<sup>10</sup> However, there is no purpose in having patent claims at all if they are assumed to include

<sup>10</sup> For the court's misplaced reliance on the *intention* of patentee, note the following passages:

Page 16:6, "Everyone admits that without the reset feature the system was position volatile. And the record supports the conclusion that Sharpless and Eichert *intended* their system to be one unhampered by position volatility."

Page 16: last line, "[T]he Sharpless-Eichert patented invention would not work as *intended*. We are of opinion that the claims at issue should not be construed so rigidly as to defeat the utility of the device as the inventors *intended* it."

Page 17:7, "That is how their system worked, and based on this record, that is what we think they *intended* to claim."

Page 24:10, "[W]e think the invention would not work in the manner *conceived* by the inventor . . . ."

any features described in the specification that the patentee may say at some point it really *intended to be used* even though not found in the claim language and even though not necessary to achieve the function actually recited in the claim. It begs the question of what is included in the claims to assume that they may also include features found only in the specification but which the patentee may later show it *intended* to have included in the claims. The very objective of Section 112 is that after describing a feature [here, the reset feature] in the specification, the patentee must *particularly* point out and *distinctly* claim its specific function in the claims if that feature is to be included as a part of the invention.

The court below compounded its error by ignoring one claim (claim 16) which patentee admits does not include the reset feature. If, as is the case here, the language of claim 16 directed to register selection does not include the reset feature, there is no perceived way the language of the other claims directed to register selection can include the reset feature.<sup>11</sup> There is, after all, only one exemplary embodiment described in the specification here at issue and, accordingly, different "means plus function" claims broadly reciting the register selection function are necessarily descriptive of the *same* register selection function. The Court of Claims held that none of the claims expressly recite the reset feature.<sup>12</sup>

The court below refers to differences of opinion between opposing experts as to their ultimate conclu-

<sup>11</sup> As the district court put it, see 394 F. Supp. at 519, "'Means' apparently 'means' only what Plaintiff 'means' it to."

<sup>12</sup> See 440 F.2d at 1368, bottom of right column.

sions of law about the claims. However, the court below adopts the agreed key fact material in this case, namely, that the register selection function may be accomplished successfully without the reset feature, albeit the latter has utility in the event of a power failure. The court below at page 7 of its decision states:

"There is general agreement here (not later binding) that a previous magnetic storage system or systems accurately located the registers as long as operation continued without interruption."

In the Court of Claims action the patentee's expert, one Shaw, testified to the same effect:

"Q. Was the ENIAC useful in scientific applications?

A. It was useful in the same sense that the EDVAC, possibly, and the UNIVAC *certainly were useful in scientific computations, even though they were information volatile.*

Q. In the event of power failure in the ENIAC and the EDVAC, the UNIVAC, and I assume you would also include the BINAC, information was lost and was it not true that the memories were reloaded with the new information and then the computation would continue from that point?

A. Yes, this could be done.

MR. YUTER: He hasn't finished.

THE WITNESS: That's all right.

By MR. STOKES:

Q. Are you finished, Mr. Shaw?

A. Yes."

(Trans. 3133:14-3134:4).

As noted above, the Court of Claims reached the same conclusion, see its reference to *normal* operation at 440 F.2d, paragraph bridging 1365-66.



In its reply to Petitioner's brief in the court below patentee-appellant stated that it was relying "—on findings of fact found by an impartial patent lawyer expert, a Court of Claims Commissioner,—." Therefore, the *agreed* material fact in this case is that the reset feature is *not necessary* to the function of register selection during *normal* operation. (And, as afore-said, the very existence of claim 16 bears this out.)

**c. Application of 35 U.S. Code 112**

The rule of law which should be settled by this Court and applied to this case is that a "means plus function" claim does not include features in the specification which are not necessary to the function actually recited in the claim. There must be a causal connection between the recited function and the features included within the ambit of the claim. Far from any causal connection, the only reason for the patentee adopting the view that the reset feature is included in the claims was to avoid the license defense set up in the Court of Claims: it was not to include anything necessary to the selection of registers.

The third paragraph of 35 U.S. Code 112 was added to the patent laws by the "1952 Patent Act", apparently to modify to some extent this Court's ruling against functional claiming in the *Halliburton* case.<sup>13</sup> The third paragraph provides that:

"An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such

<sup>13</sup> *Halliburton Oil Well Cementing Co. v. Walker*, 329 U.S. 1 (1946).

claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof."

However, the addition of the third paragraph did not serve to eliminate or modify the provision of the second paragraph, carried over from earlier statutes, that:

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention."

The question of whether the rule of the second paragraph was altered by the third paragraph came before the Court of Customs and Patent Appeals in *In re Lundberg*, 244 F.2d 543, 548 (C.C.P.A. 1957) which decided there was no modification:

"We are of the opinion, therefore, that, notwithstanding the third paragraph of section 112, it is the language itself of the claims which must particularly point out and distinctly claim the subject matter which the applicant regards as his invention, without limitations imported from the specification, whether such language is couched in terms of means plus function or consists of a detailed recitation of the inventive matter. Limitations in the specification not included in the claim may not be relied upon to impart patentability to an otherwise unpatentable claim."

Given the second paragraph of Section 112 not modified by the third, and given, as we are, the reset feature now in patentee's view vital to the invention, neither claim 19 nor claim 16 nor any other of the claims of the patent can be valid. Each is defective for the patentee having failed to draft claims "—particularly pointing out and distinctly claiming the subject matter



which the applicant regards as his invention." (Section 112). While the patentee has conceded that the reset feature is regarded as the invention, there is no way that the reset feature can be said to be *particularly* pointed out or *distinctly* claimed by the words "representative respectively" (claim 19), since the function is admittedly successfully achieved without the reset feature, and particularly since the words "—selective means—for rendering a desired one—operational—to effect a desired—recording or reading operation" (claim 16) admittedly do not include the reset feature.

**d. Claims Must Recite the Vital Feature of the Alleged Invention**

Another result of the decision of the court below is that it places the Fourth Circuit in conflict with the Sixth Circuit on the important point of patent law here presented. In *Henry J. Kaiser Co. v. McLouth Steel Corp.*, 257 F. Supp. 372 (E.D. Mich. 1966), the patent claims were held invalid under Section 112 because a feature vital to the invention was not actually recited in the claims. The court refused to allow the feature (avoidance of deep penetration of an oxygen jet) to be carried over into the claims from the specification to save the claims from defenses raised in infringement litigation. The Sixth Circuit affirmed, *Kaiser Industries Corp. v. McLouth Steel Corp.*, 400 F.2d 36 (6th Cir. 1968). This Court denied *certiorari*, 393 U.S. 1119 (1969). Now we have the Fourth Circuit in the case at bar doing exactly the opposite from *Kaiser*.

As summarized by the district court in *Kaiser*:

"There is no question on the state of this record that plaintiffs have repeatedly stated the avoid-

ance of deep penetration of the bath by the oxygen jet to be the gist of their invention. Indeed, such a position was essential to rebut the defenses of anticipation, obviousness and non-inventorship. Plaintiffs, having taken this position as to the true nature of the invention to rebut such defenses, are now bound by their position, which, as already discussed at length, is well-supported by the evidence in the record.

"For a valid patent, Section 112 requires a statement of claim or claims which particularly point out and distinctly claim the subject matter which the applicants regard as their invention. In the instant case, the avoidance of deep penetration is clearly the subject matter which applicants regarded as their invention, and yet the concept of the avoidance of deep penetration simply cannot be read into the claims of the patent in suit. The language of the claims admittedly does not refer expressly to the avoidance of deep penetration of the bath by the jet (R. 13,722), nor can any language of the claims be construed to contain such a meaning."

(257 F. Supp. at 425-26)

In *Kaiser*, the patentee had tried to read the avoidance feature into claim language such as "material agitation of the bath by the oxygen stream" and "a localized reaction zone—".

With respect to the first-mentioned clause, the *Kaiser* court said:

"[T]his Court is obliged to conclude that the avoidance of deep penetration by the jet is not necessarily causally related to the claim. . . . It is sufficient at this point to observe that no such causal relation . . . [exists] . . . that would entitle

plaintiffs to read the avoidance of deep penetration into the language of the claims. . . ."

(257 F. Supp. at 426)

With respect to the second clause the *Kaiser* court pointed out that "such a reaction zone could also exist even with deep penetration." (*i.e.*, again no causal relationship). (257 F. Supp. at 426)

The court below should have held the patent claims here in suit invalid for the same reason as in *Kaiser*, *i.e.*, a vital feature not being recited in the claims. Therefore, this Court should settle the conflict between these circuits on the issue.

The need for a causal connection between the feature in the specification and the functional recital of the claim also has been stated by the Board of Appeals of the U.S. Patent Office, see in *In re Birnbaum*, 161 U.S.P.Q. 635, 637-38 (1968):

"[W]e note that a claim may be cast in the form of a means for performing a specified function, in which event it is construed to cover the corresponding structure described in the specification and equivalents thereof *necessary* to perform the specified function in accordance with 35 U.S.C. 112, third paragraph. Therefore, if a magnetic field, or other element, is *in fact necessary* to accomplish a specified function it is necessarily included in the claim."

To the same effect by that Board is *In re Williams*, 180 U.S.P.Q. 460, 461 (1972):

"What it does mean is, that in evaluating the claim under the second paragraph of this section, the examiner is required to 'construe' the means for performing a specified function clause as 'cover-

ing' the corresponding elements and interconnections, as disclosed which are *necessary* to effect the 'specified function.'"

A decision by this Court is needed to place these very correct statements on a higher level of authority.

**e. Summary Judgment Below Should Not Preclude Review by This Court**

In closing we submit that the fact that the decisions below arose out of a motion for summary judgment should not preclude a review by this Court. While the court below makes considerable comment about summary judgment practice suggestive that the district court should not have made any decision, nevertheless the court below proceeds to reach a binding conclusion that the reset feature is included in claim 19.<sup>14</sup> Upon the remand that would occur if the decision below is not reversed the district court would be bound to include the reset feature in claim 19 and other claims, except claim 16. This *binding decision* by the court below is far different from an appellate decision which simply decides that a case was not ripe for decision on a motion for summary judgment, and remands it without making any final decision. Therefore, to settle the law, this Court should take this case and hold that with a feature agreed to be unnecessary to the function actually recited in the claims, and with that feature admittedly not specifically recited in the claims, it is not included in the claims, and all of them are therefore invalid under 35 U.S. Code 112.

<sup>14</sup> Note the conclusion of the court below at page 3 of its decision, "We are of the opinion that the claims adequately describe the invention as we consider them here."

### CONCLUSION

This petition should be granted and upon further proceedings pursuant to this petition the court below reversed and the decision of the district court reinstated.

ALLEN KIRKPATRICK, III  
1801 K Street, N.W.  
Eighth Floor  
Washington, D.C. 20006  
Telephone: 202/833-3000  
*Attorney for Petitioner*

#### *Of Counsel:*

LARRY S. NIXON  
CUSHMAN, DARBY & CUSHMAN  
1801 K Street, N.W.  
Washington, D.C. 20006  
Telephone: 202/833-3000

JOSEPH A. GENOVESE  
CONTROL DATA CORPORATION  
6003 Executive Boulevard  
Rockville, Maryland 20852

### Certificate of Service

Three copies of the foregoing Petition and the accompanying separately bound Appendix have been served under Rule 33 of this Court upon Mr. S. C. Yuter and Mr. Paul V. Niemeyer, attorneys for respondent Technitrol, Inc. by depositing same in a United States mail box, first class mail addressed to their post office addresses of record.

---

ALLEN KIRKPATRICK, III  
*Attorney for Petitioner*